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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,562	06/29/2001	Miroslav Tresky	2001-0737A	4379

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EXAMINER

NGUYEN, DONGHAI D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/869,562

Applicant(s)

TRESKY, MIROSLAV

Examiner

Donghai D. Nguyen

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

Art Unit: 3729

## DETAILED ACTION

### *Specification*

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
2. The disclosure is objected to because of the following informalities: there are no background of the invention and summary of the invention. Some part of the specification and claims are hand written. On page 6, last line, number "16" should be --18--. In claim 1, line 4 the word "constantangle" should be --constant angle--; etc.

Appropriate correction is required.

### *Drawings*

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "a tube 65" (specification page 6, line 10 and page 8, line 7) is not shown in the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the

Art Unit: 3729

invention. In the specification (page 7), last paragraph, the operation of the hand tool is unclear and questionable. When the component is touched by the vacuum tool, the contact between the contact area (57) and the contact (55) plate is interrupted, and a signal is sent to the controller (5) to switch on the vacuum. It is unclear as to when the vacuum is switched off and how? What signal is sent to the controller to turn off the vacuum?

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase, "characterized ... the spindle (27)" (lines 7-10) is vague and/or indefinite. It is unclear the exact relative positional relationship between the knob and other claim elements such as: the spindle, the vacuum tool and/or the hand grip. The phrase "notably electronic components" (line 1) is vague. The phrases "the assembly" (line 1), "the axis" (lines 4, 5, and 7-8), "the shaft" (line 5), and "the hand grip" (line 9) lack of antecedent basis.

Claim 2, the phrase "are preferably" (lines 3-4) is vague and indefinite. The phrase "the form" (line 4) lacks of antecedent basis.

Claim 6, the phrase "the electrostatic charge" (line 5) lacks of antecedent basis.

Claim 7, the phrases, "preferably in the form" (line 2) and "preferably made of steel" (line 3) are vague and indefinite, examiner does not know form and method are used or not. The phrase "the electrical wires" (line 2) lacks of antecedent basis.

Claim 10, the phrase "the cable" (line 1) lacks of antecedent basis.

Art Unit: 3729

Claim 11, the phrase “preferably placed on the housing” (lines 2-3) is vague and indefinite.

Claim 12, the phrase “an ideal ergonomic position” (line 3) is vague and indefinite.

Claim 13-16 the phrases “the electrostatic charge” (line 5) lacks of antecedent basic.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. As best as understood, claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 3,843,183 to Hutson in view of WO 8,904,547 to Tresky.

Regarding to claim 1, Hutson discloses a hand tool for assembly of small, notably electronic components with a shaft (10, 12, etc.) provided with a handle (12) and with the head part (35), a spindle (38), turning knob (62), where the axis of the spindle form a constant angle to a axis of the shaft (24) with an connector (28) between the vacuum tool and an external control device (vacuum pump, Col. 5, line 1) for switch the vacuum on and off characterized in that the axis of the turning knob is located at a distance with respect to the axis of the spindle respectively and is offset towards the handle grip, where a driving connection (55, 64) exists between the turning knob and the spindle (Figs. 1 and 9).

Hutson discloses a switching device to turn on and off the vacuum, but he does not disclose a switching device to pass signal to the control device; however, Tresky shows

Art Unit: 3729

switching device (12, 13) to pass signal for operating pneumatic witching system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hutson's switching device to pass signal to the control device as taught by Tresky for switching the control device.

Regarding claim 2, Hutson discloses a drive wheel (55) connect to the turning knob (62) is connected via an intermediate wheel (130) to the spindle wheel (64) connected to the spindle (38) in a driving connection, where the individual wheels are preferably in a form off meshing, straight-toothed spur wheels (Fig. 14).

Regarding claim 3, Hutson discloses a spindle (38) in the head part (35, 123, etc.), which can be displaced axially when the component to be handle is touch with the vacuum tool characterized in that the spindle wheel (64) connected to the spindle (38) forms part of the switching device (12 and 13 in Tresky) for passing a signal to the control device.

Regarding claims 4 and 5, Hutson discloses the spindle wheel connect to the spindle forms on contact of a mechanically actuated contact pair (Fig. 14); and the spindle forms part of an electronic sensor (Tresky's Abstract and Fig.1).

10. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutson in view of Tresky as applied to claim 1 above, and further in view of US Patent 5,048,742 to Fortune.

Hutson and Tresky do not disclose a means for mounting the hand tool, which consists of an end piece for mounting in a fork-shaped holder. However, Fortune discloses a means for mounting the handle tool, which consists of and end piece (190; etc.) for mounting in a fork-shaped holder (Figs. 13) to provide a convenient and efficient resting place for the hand tool. It

Art Unit: 3729

would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hutson's hand tool to have a end piece for mounting in a fork-shaped holder as taught by Fortune to provide a convenient and efficient resting holder for a hand tool.

***Allowable Subject Matter***

11. Claims 6-10 and 13-18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

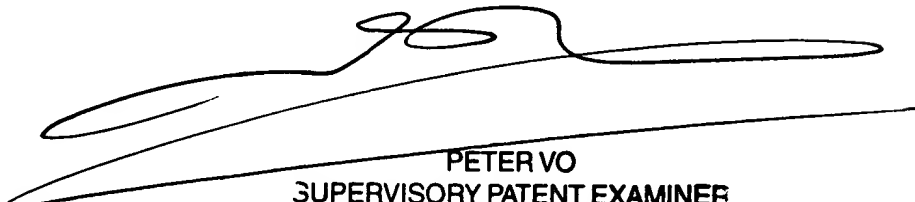
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (703) 305-7859. The examiner can normally be reached on Monday-Friday (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7307 for regular communications and (703) 305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

DN  
November 4, 2002



PETER VO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700